



May 3, 2006

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2627 - Examiner: Craig A. Renner

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/661,038
File Date: 09/12/03
Inventor: Cheng T. Horng et al.
Examiner: Craig A. Renner
Art Unit: 2627
Title: PROCESS AND STRUCTURE TO FABRICATE SPIN VALVE
HEADS FOR ULTRA-HIGH RECORDING DENSITY
APPLICATION

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated 04/18/06. In that office action, restriction was required to one of the following Inventions under 35 U.S.C. 121:

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 4, 2006.

Signature
Stephen B. Ackerman, Reg. No. 37,761

Date: 5/4/06

The inventions stated are:

- I – Claims 1-12 drawn to a method for forming a bottom spin valve GMR sensor element, classified in class 29, subclass 603.08, and
- II – Claims 13-21, drawn to a bottom spin valve GMR sensor element, classified in class 360, subclass 324.1.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I – Claims 1-12 drawn to a process classified in Class 29, subclass 603.08. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "a bottom spin valve GMR sensor element with ultra-thin layers of high density and smoothness and having sub-atomic monolayers of oxygen absorbed on the surfaces thereof", and that the product claims are directed to "a bottom spin valve GMR sensor element having ultra-thin layers of high density and smoothness with sub-monolayer thick

surface oxygen layers thereon ", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 29/603.08 and product class/subclass 360/324.1, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the product as claimed can be made by another and materially different process, such as, a process not including using an ultra-low pressure Ar/O₂ mixture as a sputtering gas" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



Stephen B. Ackerman, Reg. No. 37,761